

Application No.: 09/943,955

Docket No.: 5918/04/FPS/MMCS/APC/DV

PATENT/OFFICIAL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

SHANMUGASUNDRAM et al.

Serial No. 09/943,955

Filed: August 31, 2001

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Group Art Unit: 1765

Examiner: L.T. Umez-Eronini

For: FEEDBACK CONTROL OF CHEMICAL MECHANICAL POLISHING DEVICE
PROVIDING MANIPULATION OF REMOVAL RATE PROFILES

CERTIFICATE OF FIRST CLASS MAILING UNDER 37 CFR § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

Date:

Feb. 5, 2004

Janet McKean
Janet McKean

RESPONSE TO RESTRICTION REQUIREMENT

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This communication is in response to the Office Action mailed December 2, 2002, having a one-month shortened statutory period of response set to expire by January 2, 2004. A Petition for Extension of Time, together with the requisite fee for same, is submitted herewith, thereby extending the period of response to March 2, 2004. The following remarks are respectfully submitted.

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PROVISIONAL ELECTION

Applicant hereby provisionally elects Group I (claims 1-27) for prosecution, with traverse.

TRAVERSAL OF RESTRICTION REQUIREMENT

The restriction requirement is respectfully traversed for the following reasons: (1) the restriction is improper since reasonable examples of material differences were not provided; (2) there appears to be no serious burden on the Examiner necessitating the restriction requirement; and (3) the application, as amended, includes a linking claim, thereby rendering the restriction improper.

With respect to Groups I and II and regarding (1) above, the Examiner cited MPEP § 806.05(e), which states that inventions are distinct if it “can be shown: (A) the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus as claimed can be used to practice another and materially different process.” The Examiner appears to have indicated that both of these factors were applicable to the present application. However, it was not made clear by the Examiner why this would be the case. In particular, no examples were provided by the Examiner, in contravention of the examples of material differences required by MPEP § 806.05(e). Specifically, § 806.05(e) states that “the burden is on the examiner to provide reasonable examples that recite material differences.” *Id.* Consequently, should the Examiner maintain the restriction, Applicant respectfully submits that such examples be provided.

With respect to Groups I and III and regarding (1) above, the Examiner cited MPEP § 806.05(h), which states that inventions are distinct if it “can be shown: (A) the process for using

the product as claimed can be practiced with another materially different product; or (B) that the product as claimed can be used in a materially different process of using that product.” The Examiner appears to have indicated that factor (B) was applicable to the present application, noting that the claimed product could be used in a process that does not require polishing a wafer. However, it was not made clear by the Examiner why this would be the case. In particular, the product is “a computer-implemented software application for a chemical mechanical polishing process.” It is not apparent how the product is used in a process that does not include polishing a wafer. Consequently, should the Examiner maintain the restriction, Applicant respectfully request that such alternative uses be further clarified.

Regarding (2) above, the Restriction Requirement cited class/subclass combinations to search:

Group I: 438/14 (polishing method)

Group II: 451/1⁺ (polishing apparatus)

Group III: 356/1⁺ (computer readable medium)

It is believed that the search for Groups I, II and III is not well taken as a material difference, since all invention groups relate to substrate thickness control in a polishing operation, and the invention could reasonably be searched in class/subclass 483/14. Consequently, there appears to be no serious burden on the Examiner necessitating the restriction requirement, as would be required as indicated in the introductory paragraphs of MPEP § 803.

Lastly, regarding (3) above, Applicant submits herewith a Preliminary Amendment, including a linking claim (new claim 33) of the type indicated by MPEP § 806.05(e).

As regards to Groups II and III, the Examiner cited MPEP § 808.01, which states that inventions are independent if they are not connected in design, operation or effect under the disclosure of the particular application under consideration. This is not the case here, as the controller of the apparatus of Group II is related by design, operation and/or effect to the instructions provided by the computer readable medium of Group III.

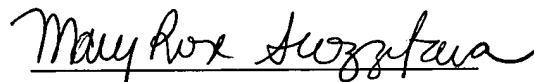
For the reasons given above, the Examiner is respectfully requested to reconsider and withdraw the restriction requirement.

AUTHORIZATION

The Applicant petitions for an extension of time to extend the period of response up to and including March 2, 2004. The Commissioner is hereby authorized to charge the petition fee set forth in 37 C.F.R. § 17(a)(2) and any additional fees should they be required for this submission, or credit any overpayment to deposit account no. 08-0219.

Respectfully submitted,

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